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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ALFONS EIZENHOFER, PETER KUCZYNSKI,  
and SAID TATESH

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Appeal 2007-3650  
Application 09/356,260  
Technology Center 2100

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Decided: September 26, 2008

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Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and  
THU A. DANG, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 20-38, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Claim 29 is illustrative.

29. A method of transmission in a multi-frame system, each frame of the multi-frame system being associated with a first type of control information, there further being provided a second type of control information comprising a code word, wherein each frame of a plurality of consecutive frames in the multi-frame sequence is transmitted with the first type of control information for the respective frame; and a section of a partitioned second type of control information the number of frames of the plurality of consecutive frames in the multi-frame sequence corresponding to the number of sections into which the control information is partitioned, the method comprising:

- a. receiving frames of the multi-frame; and
- b. reforming the sections of the second type of control information into the code word.

The Examiner relies on the following references as evidence of unpatentability.

Dahlin	US 5,199,031	Mar. 30, 1993
Paneth	US 6,014,374	Jan. 11, 2000
Le Strat	US 6,134,220	Oct. 17, 2000
Wan	US 6,385,460 B1	May 7, 2002
Roberts	US 6,418,558 B1	Jul. 9, 2002

Claims 20-22, 25, 29, and 32-34 stand rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Roberts and Paneth.

Claims 23, 24, 31, 37, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Roberts, Paneth, and Le Strat.

Claims 26-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Roberts, Paneth, and Dahlin.

Claims 30 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Roberts, Paneth, and Wan.

Claim 36 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Roberts, Paneth, Wan, and Le Strat.

The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). The one who bears the initial burden of presenting a *prima facie* case of unpatentability is the Examiner. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The Examiner sets forth the rejection of claim 29 at pages 11 and 12 of the Answer. Roberts is deemed to teach the subject matter of the claim, but does not “expressly teach” control information comprising a code word, and reforming the control information into the code word. Paneth “provides a definition of code word as control information.” The “control information” is reformed by Roberts, and this “control information is the code word” as per Paneth. (Ans. 12; *see also ¶* bridging Ans. 45-46.)

Although the nominal statutory basis for the rejection is 35 U.S.C. § 103(a), the rationale in support of the rejection appears to be consistent with a rejection for anticipation (§ 102), which seems to have created confusion in the instant appeal. Paneth appears to be relied upon for no more than providing the term “code word.” (*See, e.g., ¶* bridging Ans. 45-46.) However, arrangement of the “control information” referenced in Roberts can be considered a “code word” within the meaning of the instant claims, as Appellants have not provided any special definition of the term that would distinguish over use of the “control information” of Roberts.

The rejection thus appears to be, in essence, a rejection for anticipation over Roberts, with extrinsic evidence (Paneth) provided to show that the artisan would understand arrangement of the “control information” in Roberts to be within the meaning of a “code word” as claimed. We consider Paneth to represent merely cumulative evidence in the rejection of claim 29, as nothing in this record establishes that the recitation “code word” distinguishes over use of the “control information” that Roberts describes.

In any event, the Examiner considers Roberts to teach receiving frames of the multi-frame, and reforming the (partitioned) sections of the second type of control information into the code word, as required by claim 29. The rejection reads the “control information” on the ninth bit signal (NBS) described by Roberts.

Roberts at Figure 9 shows a 125  $\mu$ sec frame having 320 bit periods. Roberts adds a ninth bit to a prior art eight bit “DS0” signal, which yields a “DS0+” format. Twenty-four DS0+ channels, plus overhead, may be used within each frame. The NBS can carry multiframe timing, out-of-band signaling bits, and miscellaneous status and control information associated with each DS0. Roberts col. 30, ll. 21-55. “The ninth bit signal (NBS) carries a pattern which is updated each frame and repeats every 24 frames.” *Id.*, ll. 35-36. Figure 9 depicts a single (125  $\mu$ sec) frame of a multiframe signal. *See* col. 30, l. 64 - col. 31, l. 12; col. 32, l. 59 - col. 33, l. 23.

Roberts further details use of the NBS at column 98, line 62 through column 100, line 21, with examples of upstream (Table 9) and downstream (Table 10) signaling.

Roberts does not expressly disclose that the NBS signal is partitioned into sections and reformed over multiple (i.e., at least two) frames, at least not within the portions of Roberts referenced by the rejection of claim 29. We have studied the reference, with careful consideration of the Examiner's position (*e.g.*, Ans. 35-37), but we do not find a clear teaching of the subject matter that the rejection attributes to Roberts.

Absent a clear teaching in the reference, or a convincing explanation from the Examiner as to how Roberts might teach an operation within the requirements of claim 29, we are constrained to agree with Appellants that the rejection fails to set forth a *prima facie* case for unpatentability.

The rest of the independent claims (20, 32, 33, and 34) are also rejected over Roberts and Paneth, with similar deficiencies in those rejections. As the references applied with Roberts and Paneth against dependent claims do not remedy the deficiencies in the rejections against the base claims, we cannot sustain the rejection of any claim on appeal.

#### CONCLUSION

The rejections of claim 20-38 under 35 U.S.C. § 103(a) are reversed.

REVERSED

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AGERE  
LERNER, DAVID et al.  
600 SOUTH AVENUE WEST  
WESTFIELD NJ 07090